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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---------------------------|-------------|----------------------|---------------------|------------------|
| 09/607,069 | 06/29/2000 | Jie Cheng | 200-0382 | 7285 |
| 28395 | 7590 | 06/29/2004 | EXAMINER | |
| BROOKS KUSHMAN P.C./FGTL | | | FISHER, MICHAEL J | |
| 1000 TOWN CENTER | | | ART UNIT | PAPER NUMBER |
| 22ND FLOOR | | | | |
| SOUTHFIELD, MI 48075-1238 | | | 3629 | |

DATE MAILED: 06/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------------|------|
| Office Action Summary | Application No. | Applicant(s) | |
| | 09/607,069 | CHENG ET AL. <i>MJ</i> | |
| | Examiner | Art Unit | 3629 |
| | Michael J Fisher | | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 04 March 2004.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 23,24 and 26-41 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 23,24 and 26-41 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date: _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 33-41 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The formulae in claims 33,35 and 36 are incomplete. While they list variables to be used, they do not explain how to use the variables, as there is no mention in the specification as to how to combine the variables to achieve the stated results, there is no way to use these claims.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 23,24 and 26-41, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over N.A.D.A. web page from 11/1999. (NADA) NADA discloses a method for determining a vehicle's price which includes checking historical values for cars (paragraph 2 on page 1) and using this to generate values for autos. While they don't specifically mention adjusting for error, this would be

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inherent. It is further inherent in the NADA that they user compares the values in the book to a similar car. There are factors listed that increase and decrease the value of the auto, including; high mileage, low mileage, automatic or standard transmission, air conditioning, sound system, power accessories, region, sun/moon roof, spoiler, alloy wheels et al. NADA is generally regarded as one of the best sources for automobile prices because they have a low error and as such are used in many automobile dealerships as a guide to the value of used cars for trade-ins. They further compare comparable vehicles for their prices and adjust the prices for other vehicles, they have a price for average and then list prices for clean, rough and further list a wholesale price. These values would be distance weighted from the average price. The NADA book further is region-specific and thus, there would be the ability to determine distance between autos.

Response to Arguments

As to arguments involving the formulae in claims 33,35 and 36, they are not complete. Further, the applicant remarks that "(please note the variables v1 and v2 are used in a different context than claim 33)". This would appear to reinforce the examiner's arguments that the formulae are unclear as there are acknowledged by applicant different uses for the same variables. This, coupled with vague references to using variables in a formula without explaining the exact formula, would not allow one of ordinary skill in the art to make and/or use the invention. Further, applicant lists two Errors, p and k, without explaining how to compute the error. Thus, there is no

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enablement. For instance, in claim 33, is the limitation "B) determining an Error k based on V1, Const, F d, K and Error p"..." There is no way to understand how to determine the "Error k". Determining errors is especially important in the used vehicle guide area as a reference that contains many errors would stop being used, therefore, it would be inherent that NADA tries to reduce errors else their reliability would go down and auto dealers would not use their guides. As to applicant's arguments that the NADA book does not disclose certain criteria, such as number "K" of vehicles, the examiner has asserted and still asserts that these criteria are inherent. The number of cars in the database would be "K", whether specifically labeled or not. As previously recited by the examiner, the NADA book is issued in various regions of the country and is used exclusively in those areas. A book from the West Coast would not be used in the Northeast, thus establishing 'neighborhoods'. While applicant states that the numbers "K" and "N" are selected, this would appear to be the method that NADA uses, their 'K' is the amount of vehicles used. The subset of "neighbor vehicles" would be those in the same region. For instance, a convertible Honda is worth 'X' in Washington, DC, while the same car would be worth 'X-Y' in upstate NY where prices are lower. Thus, the convertible Hondas in upstate NY would not be used to determine the value of a convertible Honda in Washington and would not be considered a 'neighbor'.

Response to Amendment

The affidavit under 37 CFR 1.132 filed 3/4/04 is insufficient to overcome the rejection of the claims based upon Nada as set forth in the last Office action because:

While the affidavit claims that there is sufficient explanation in the Detailed Description of the instant application, and while the claims are to be read in view of the specification, there is insufficient enablement in the claims and the specification for the formula presented. Specifically, there is no way to understand how to combine the variables to achieve the outcome specified in the claims. The examiner understands the variables, however, there is no way to understand how to combine them from the claims to achieve the desired result and therefore, different people, combining the variables in different ways would achieve wildly different results and could both be infringing on the patent if granted.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J Fisher whose telephone number is 703-306-5993. The examiner can normally be reached on Mon.-Fri. 7:30am-5:00pm alt Fri. off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 703-308-2702. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MF
6/27/04


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